

the PTO-Form 1449 initialed by the Examiner to acknowledge that the Examiner has considered the disclosed information. Applicant respectfully requests the Examiner to consider the references filed on February 18, 2000, and to initial and return to the undersigned the PTO-Form 1449. For the convenience of the Examiner, a copy of the PTO-Form 1449 is enclosed.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 35 has been rejected under 35 U.S.C. § 112, second paragraph, as indefinite for reciting "a medium suitable for dyeing" with respect to a process. Claim 35 has been amended to make clear that it is the dyeing composition used in the claimed process which may contain a medium suitable for dyeing. Accordingly, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a)

Claims 16-40 have been rejected under 35 U.S.C. § 103(a) over Terranova (WO 97/49378) for the reasons set forth at pages 2-4 of the Office Action. The Examiner states that "Terranova does not exemplify a dyeing composition, process, or kit as claimed, particularly which contains or uses the claimed second oxidation base." Office Action, dated December 7, 2000, at 3. The Examiner further states that it would have been obvious to formulate the claimed composition because it would have been obvious to add the claimed second oxidation base to Terranova's exemplified compositions and processes, because the patentee teaches that the

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additional oxidation base may be added to the patentee's compositions, and "it is known and conventional in the hair dyeing art to mix different oxidation bases and couplers in order to obtain a wide variety of colors, absent a showing otherwise."

Id. at 4. Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the prior art reference must either teach or suggest all the claim elements, must provide some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and there must be a reasonable expectation of success. M.P.E.P. § 2143 (7th ed. 1998). Furthermore, the teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness here.

Terranova teaches a composition comprising at least one specific pyrazolo[1,5-a]pyrimidine derivative. Abstract.¹ Additionally, Terranova teaches that the composition may also contain at least one additional oxidation base, chosen from a long laundry list of oxidation bases, such as, for example, N,N'-

¹ Since WO 97/49378 is in French, all references in this response refer to U.S. Patent No. 6,093,593, an English-language equivalent of the WO reference.

bis(β -hydroxyethyl)-para-phenylenediamine. Col. 6, lines 13-58. However, as acknowledged by the Examiner, Terranova does not teach any compositions in its 32 examples which comprise both pyrazolo[1,5-a]pyrimidine derivative and any other oxidation base, let alone the claimed at least one second oxidation base, N,N'-bis(β -hydroxyethyl)-para-phenylenediamine.

Moreover, at col. 7, Terranova teaches the addition of any coupler, from a laundry list of couplers, with its pyrazolo[1,5-a]pyrimidine derivative, but does not teach or suggest that a particular type of coupler should be used in combination with the pyrazolo[1,5-a]pyrimidine derivative. In fact, the examples illustrate that any of several couplers in combination with the pyrazolo[1,5-a]pyrimidine derivative would provide the same result. However, Terranova does not teach or suggest a composition comprising its pyrazolo[1,5-a]pyrimidine derivative in combination with the claimed at least one coupler and the claimed at least one second oxidation base, N,N'-bis(β -hydroxyethyl)-para-phenylenediamine.

Thus, although the Examiner argues that the teachings in Terranova make the claimed invention obvious, Applicant respectfully disagrees. At most, the teachings in Terranova would make it *obvious to try* combining its pyrazolo[1,5-a]pyrimidine derivative with various couplers, such as in his own examples, and possibly to even *try* adding in any additional second oxidation base, even though this was not shown in his examples. However, as the Examiner knows, obvious to try is not the correct standard.

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Moreover, there is no particular teaching or suggestion in Terranova that would motivate one of ordinary skill in the art to add a second oxidation base to the compositions of Terranova with any reasonable expectation of success.

Specifically, since there is no apparent disadvantage in using only one oxidation base in a composition, as demonstrated by his examples, one of ordinary skill in the art would not be motivated to modify the composition to add a second oxidation base.

In sum, the teachings in Terranova are too broad to motivate one of ordinary skill in the art to make three specific selections, thereby arriving at the claimed composition. Specifically, there is no teaching, suggestion, or motivation in Terranova so that one of ordinary skill in the art would select the claimed at least one first oxidation base, the claimed at least one second oxidation base, and the claimed at least one coupler.

For at least the foregoing reasons, Terranova would not have rendered obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Please grant any extensions of time required to enter this amendment and
charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 7, 2001

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APPENDIX TO AMENDMENT DATED MAY 7, 2001

AMENDMENTS TO SPECIFICATION

Please amend the specification as follows:

Please replace page 4, lines 1 - 12 with the following:

R₁, R₂, R₃ and R₄, which are identical or different, denote a hydrogen atom, a (C₁-C₄) alkyl radical, an aryl radical, a hydroxy (C₁-C₄) alkyl radical, a polyhydroxy (C₂-C₄) alkyl radical, a (C₁-C₄) alkoxy (C₁-C₄) - alkyl radical, an amino (C₁-C₄) alkyl radical (it being possible for the amine to be protected by an acetyl, [a ureido] an amido or a sulphonyl), a (C₁-C₄) alkylamino (C₁-C₄) alkyl radical, a di [(C₁-C₄) alkyl] amino (C₁-C₄) alkyl radical (it being possible for the dialkyls to form a 5- or 6-membered aliphatic or heterocyclic ring), a hydroxy (C₁-C₄) alkylamino (C₁-C₄) alkyl radical or a di [hydroxy (C₁-C₄) alkyl] amino (C₁-C₄) alkyl radical;

AMENDMENTS TO THE CLAIMS

Please amend claim 35 as follows:

35. (Amended) The process according to claim 32, [comprising] wherein said at least one dyeing composition comprises a medium appropriate for dyeing